

REMARKS

Prior to the present reply, claims 1 and 56-88 were pending. Applicants elected compound 22 (D-Lys(4-nitrobenzoyl-Gly-OH) for examination. Claim 85 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office further objects to claims 1 and 56-88 as not having been amended commensurate in scope with the elected invention. The rejection and the objection are addressed below.

Claim amendments

Claims 1, 57, 61, 66, 67, 69-73, 75-77, 79, 83, and 85 have been amended, claims 58-60, 74, and 81-82 have been cancelled, and new claim 89 has been added. Claim 1 has been amended to recite that z is 4, p is 1, x and q are 0, y is 1, d is 0, and R₁ is the amino acid side chain of glycine. Support for these changes is found, for example, in original claim 1. Claim 57 has been amended to depend from claim 1 and recite that the peptide comprises at least one D amino acid. Support for this change is found, for example, at page 8, lines 8-9. Claim 79 has been amended to remove compounds that do not read on amended claim 1. Claim 85 has been amended to delete “or preventing” and to depend solely from claim 1. Claims 61, 66, 67, 69-72, 75-77, and 83 have been amended solely with respect to claim dependency. Claim 73 has been amended for clarity. New claim 89 recites the elected species. These amendments add no new matter.

Rejection under 35 U.S.C. § 112, first paragraph

Claim 85 is rejected as failing to comply with the enablement requirement. Specifically, the Office indicates that the specification, while enabling for treating arrhythmias using a peptide of Compound 22, does not reasonably provide enablement for preventing the same, where the Office notes “that the term ‘preventing’ is an absolute definition, which means to stop from occurring.” Page 3 of the action. Without assenting to the rejection and in view of the Office’s interpretation of this term, applicants have amended claim 85 to delete “or preventing,” with the understanding that by reciting “treatment,” the claim continues to cover all but absolute prevention. Thus, this rejection is now moot. The enablement rejection may therefore be withdrawn.

Claim objection

The Office has objected to claims 1 and 56-88 as not having been amended commensurate in scope with the elected invention. Applicants submit that this objection is improper, as this application is a national stage application, and is subject to the unity of invention standard set forth in 37 C.F.R. §§ 1.475 and 1.499. As the Office has not provided any evidence to demonstrate the claims lack unity of invention, applicants submit that this objection lacks any basis, and that the claims should be examined over their full scope.

Nonetheless, and solely to expedite prosecution, applicants have amended the claims to cancel subject matter reading on peptides other than substituted Lys-Gly and

Gly-Lys dipeptides. Specifically, claim 1 has been amended to recite that $z=4$ and $y=1$, thus representing the side chain of lysine. Claim 1 has been further amended to recite that R_1 is the side chain of glycine. Finally, claim 1 has been amended to recited that $d=0$. On the basis of these amendments, the claim 1 reads on substituted Lys-Gly and Gly-Lys peptides. Claim 57, as amended, depends from claim 1 and recites that the peptide includes at least one D amino acid. Claim 58-60 are cancelled, and peptides which do not read on amended claim 1 have been deleted from the remaining dependent claims. The claims, as amended, thus recite only substituted Lys-Gly and Gly-Lys peptides, and examination over full scope of the claims is respectfully requested.

Finally, in the Supplemental Restriction Requirement mailed June 15, 2007, the Office indicated that a search of all specifically identified substitutions (e.g., those of Table 1) of the elected dipeptide would be performed.. In the Reply to Restriction Requirement dated October 15, 2007, applicants elected Compound 22, a substituted Lys-Gly compound, for examination. However, the Office has not performed a search of specifically identified substituted Lys-Gly compounds, as was indicated by the Office. For this reason as well, applicants respectfully request examination be extended.

CONCLUSION

Applicants submit that the claims are in conditions for allowance and such action is respectfully requested. If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: _____

June 24, 2008

Kristina Bieker-Brady

Kristina Bieker-Brady, Ph.D.
Reg. No. 39,109

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045